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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/039,231   | 12/31/2001  | Kangsheng Wang       | 267/211             | 8185             |
| 34055  | 7590        | 03/02/2004           | EXAMINER            |                  |
| PERKINS COIE LLP<br>POST OFFICE BOX 1208<br>SEATTLE, WA 98111-1208 |             |                      | TON, THAIAN N       |                  |
|  |             |                      | ART UNIT            | PAPER NUMBER     |
|  |             |                      | 1632                |                  |

DATE MAILED: 03/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                        |                     |  |
|------------------------------|------------------------|---------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |  |
|                              | 10/039,231             | WANG ET AL.         |  |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |  |
|                              | Thai-An N Ton          | 1632                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-51 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-51 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some    c) ☐ None of:  
         1. ☐ Certified copies of the priority documents have been received.  
         2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
         3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
     \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
     a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                            | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____   |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)        | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ | 6) <input type="checkbox"/> Other:  |

## DETAILED ACTION

### *Election/Restrictions*

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-19, 25-31, 33-38, drawn to methods of associating at least one polynucleotide molecule to a non-human sperm cell through at least one non-liposome based linker, effecting *in vitro* fertilization of a non-human egg cell with the non-human sperm cell, an article of manufacture comprising an antibody, sperm cell and a polynucleotide, classified in class 435, subclass 320.1, class 800, subclasses 4, 21, for example.
- II. Claims 1-19, 25-31, 33-38, drawn to methods of associating at least one polynucleotide molecule to a non-human sperm cell through at least one non-liposome based linker, effecting *in vivo* fertilization of a non-human egg cell with the non-human sperm cell, an article of manufacture comprising an antibody, sperm cell and a polynucleotide, classified in class 800, subclass 4, 21; class 435, subclass 320.1; class 424, subclass 184.1, 278.1, 93.1, 93.2, 93.21, for example.
- III. Claims 20-24, 32-34, drawn to a non-liposome based linker comprising an antibody that is characterized by having binding affinity to a sperm cell, classified in class 530, subclass 387.1.
- IV. Claims 39-44, drawn to a chicken comprising a nucleic acid encoding human interferon, classified in class 800, subclass 8, 19, for example.
- V. Claims 45-51, drawn to methods for a high-throughput functional screening of a plurality of polynucleotides, classified in class 702, subclass 19.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and any of Inventions II, IV, or V are mutually exclusive and independent inventions. The *in vitro* methods of Invention I are not required for the implementation of the *in vivo* methods of Invention II, the chicken of Invention

IV, and the methods of high-throughput functional screening of Invention V, and vice versa. Furthermore, each of the methods of Inventions I, II, and V requires a separate and materially different protocol.

Inventions II and either of Inventions IV or V are mutually exclusive and independent. The *in vivo* methods of Invention II are not required for the implementation of the chicken of Invention IV, and the methods of high-throughput functional screening of Invention V, and vice versa. Furthermore, each of the methods requires a separate and materially different protocol.

Inventions III and either of Inventions I or II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the antibodies of Invention III can be used in immunological assays, for example.

Inventions IV and V are mutually exclusive and independent. The chicken of Invention IV is not required for the implementation of the methods of high-throughput functional screening of Invention V, and vice versa.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Art Unit: 1632

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Thaian N. Ton whose telephone number is (571) 272-0736. The Examiner can normally be reached on Monday through Friday from 8:00 to 5:00 (Eastern Standard Time), with alternating Fridays off. Should the Examiner be unavailable, inquiries should be directed to Amy Nelson, Acting SPE of Art Unit 1632, at (571) 272-0804. Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Group 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CM1 Fax Center number is (703) 872-9306.

TNT

Thaian N. Ton  
Patent Examiner  
Group 1632



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